REMARKS

Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sayer et al. (US patent 6,539,237) in view of Mazur et al. (US Patent 6,580,910).

Regarding independent claims 1 and 3, the Examiner's interpretation of the description of Sayer et al. and Mazur et al. patents needs further clarification in order to distinguish the present invention from these references.

MPEP paragraph 2143 states:

"To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. ***In re Vaeck***, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

Regarding independent claims 1 and 3 of the present invention, the Examiner does not show that the references he quoted contain all the claim limitations as required by the third criterion (prior art references when combined must teach or suggest all the claim limitations) of the MPEP paragraph 2143 to establish a *prima facie* case of obviousness.

In particular, the Examiner alleges that Sayer et al. (col. 23, lines 6-15, 20-30) describe "signaling from a source radio network subsystem to a core network or to a target radio network

subsystem that said handover is required" as stated in claim 1 of the present invention. Sayer et al. (col. 23, lines 6-15, 20-30) talk about handover ("There are several methods used to facilitate the handover process", col. 23, lines 26-27) but do not teach about said signaling for requesting handover at all.

Furthermore, the Examiner alleges that Sayer et al. (col. 23, lines 53-55 and col. 24, lines 1-10) teach "transmitting optimized algorithm parameters from a source radio network subsystem to said target radio network subsystem directly or via the core network without any need for renegotiating said parameters over an air interface between said mobile station and said target radio network subsystem." Sayer et al. not only do not teach the fact that it is not necessary to renegotiate said parameters, they even do not mention, suggest or even hint that said negotiations are needed in the first place. Sayer et al. do not even mention the word "parameter" or "optimized algorithm parameters" at all and requesting resources (col. 23, lines 53-55: "At this point the Old BTS (EP1) must request the resources from the Target BTS") has nothing to do with optimized algorithm parameters and negotiating or renegotiating such parameters.

Regarding claim 1 of the present invention, the Examiner admits that Sayer et al. do not "teach parameters of an optimization algorithm during a connection handover". Here the Examiner contradicts himself: if Sayer et al. do not tech optimized algorithm parameters (which is admitted by the Examiner), how at the same time Sayer et al. can teach "transmitting optimized algorithm parameters from a source radio … without any need for renegotiating said parameters …" as quoted above. Furthermore, the Examiner alleges that Mazur et al. teach parameters of an optimization algorithm (Abstract, col. 2, lines 64-67, and col. 3, lines 1-4). Mazur et al. describe (see

abstract) a method and system disclosed "for making inter-cell handoffs to a cell of a base station including a directional antenna array". Mazur et al. continue: "The handoff algorithm includes taking into account uplink direction of arrival measurements in at least one candidate target base station, made on signals from the mobile radio terminal to it's serving base station, and directly after handoff using a directional narrow lobe from the antenna array. The narrow lobe can be used immediately after the handoff in the radio base stations that have antenna arrays, by including the direction (of arrival information) to the mobile radio terminal in the handoff order to the target base station".

Mazur et al. do not talk at all about optimization algorithm parameters, or parameters related to communications between an SRNS (serving radio network subsystem) and an MS simply because Mazur et al.'s system does not contain SRNSs. The only "parameter" taught by Mazur et al. is a direction-of-arrival information (DOA) where they discuss ways of improving power and interference performance during and after handoffs, such as narrow lobe vs. wide lobe traffic channel alternatives (col.2, line 64 through col 3., line 4): "An important technical advantage of the present invention is that by reporting the DOA information about the MS to be handed off, and the interference of the possible narrow lobe target channels in the same DOA, the network controller can use a simple handoff algorithm to choose between narrow lobe and wide lobe traffic channel alternatives for all types of BSs using comparable criteria, such as, for example C/I".

Thus Mazur at al.'s "parameter" has nothing to do with the optimization algorithm protocol parameters described by the present invention.

The remarks presented above for rebutting claim 1 rejection are fully applied to rebutting claim 3 as well, because claim 3 in an independent system claim with the same scope as an independent method claim 1.

Even if, in regard to independent claims 1 or 3, for the sake of argument only, we consider that it is possible (which is actually not true since the references quoted by the Examiner do not contain all claim 1 or 3 limitations, as shown above) to combine teachings of Sayer et al. and Mazur et al. to make the present invention obvious, the Examiner does not show that the references he quoted contain suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings to arrive at the subject matter of claims 1 and 3 of the present invention as required by the first criterion of MPEP paragraph 2143 quoted above, or to accomplish that without the benefit of hindsight as required by the case law.

Withdrawal of the 35 U.S.C. 103(a) rejection of claims 1 and 3 is requested.

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Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sayer et al. (US patent 6,539,237) in view of Mazur et al. (US Patent 6,580,910) and further in view of Bark et al. (US Patent 6,445,917)

Regarding claims 2 and 4, these are dependent claims of novel and non-obvious independent claims 1 and 3, as shown above. Since each of these dependent claims narrows the scope of novel and non-obvious independent claims 1 and 3 respectively, non-obviousness of claims 1 and 3 will compel non-obviousness of claims 2 and 4.

Another way to rebut to the 35 U.S.C.103(a) rejection of

claims 2 and 4 is by analyzing MPEP guidelines which are stated in the MPEP Paragraph 2143 and quoted above. Indeed, the Examiner admits the fact that Sayer et al. and Mazur et al. do not teach establishing various optional sets of parameters, only one of which is accepted by a source radio network subsystem, and storing optional sets of parameters wherein a step of transmitting a parameter includes transmitting all optional sets of parameters. The Examiner alleged that Bark et al. teach that. That is not accurate. For example Buck does not teach storing optional sets of parameters wherein a step of transmitting a parameter includes transmitting all optional sets of parameters (col. 7, lines 39-42 and 57-58). Buck et al. only talk about possibility of specifying and measuring qualitative and/or quantitative parameters (col. 7, lines 57-58), etc.

Thus the Examiner does not show that the references he quoted contain all the claim limitations of claims 2 and 4 as required by the third criterion (prior art references when combined must teach or suggest all the claim limitations) of the MPEP paragraph 2143 to establish a *prima facie* case of obviousness.

Also, similarly to the above discussions regarding independent claims 1 and 3, the Examiner does not show that any of the three references he quoted contain suggestion or motivation expressed explicitly, implicitly or even hinted at, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings to arrive at the subject matter of claims 2 and 4 of the present invention as required by the first criterion of MPEP paragraph 2143, quoted above. Therefore, it is highly unlikely that somebody of ordinary skill in the art would have been reasonably expected to combine three references (teaching 3

different components of claim 2 or 4) quoted by the Examiner and to find the solution claimed by the Applicant without the benefit of hindsight (also as required by the MPEP paragraph 2143 referenced above and by the case law).

Withdrawal of the 35 U.S.C. 103(a) rejection of claims 2 and 4 is requested.

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The rejections of the Official Action of April 14, 2004, having been obviated or shown to be inapplicable, withdrawal thereof is requested, and passage of the claims to issue is earnestly solicited.

Respectfully submitted,

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